

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claims 81 and 83 have been cancelled without prejudice or disclaimer.

Each of claims 80 and 82 have been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 84 through 93 have been added. Claims 80 through 93 are now pending in this application. Claims 80 and 82 are the independent claims.

I. The Objection to the Specification

In the Office Action, the Specification was objected to because the title of the invention was allegedly not descriptive. It is respectfully submitted that the title of the invention has been amended herein to render it more descriptive. Therefore, Applicants respectfully submit that any grounds for this objection have been removed, and respectfully request acknowledgment thereof.

II. The Anticipation Rejection

Claims 80 and 82 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, New et al. (U.S. Patent No. 6,150,839) was cited. This rejection is respectfully traversed.

New fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged

as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385 (Fed. Cir. Jan. 6, 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

Claim 80, upon which claims 84 through 88 depend, recites “a directory adaptable to report function calls of said programmable logic controller”. Claim 82, upon which claims 89 through 93 depend, recites “reporting a directory of function calls of said programmable logic controller”. New does not teach expressly or inherently either “a directory adaptable to report function calls of said programmable logic controller” or “reporting a directory of function calls of said programmable logic controller. Accordingly, it is respectfully submitted that the rejection of claims 80 and 82 are unsupported by New and should be withdrawn.

III. The Obviousness Rejection

Claims 81 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of New et al. (U.S. Patent No. 6,150,839) in view of Boggs et al. (U.S. Patent No. 6,594,529).

Claims 81 and 83 have been cancelled. Notwithstanding the cancellation of these claims, the use of Boggs as a basis for any obviousness rejection is respectfully traversed.

The present application and U.S. Patent No. 6,594,529 (Boggs) were, at the time the invention of the present application was made, owned by or subject to an obligation to assign to Siemens Energy & Automation.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 19-2179. The Examiner is invited to contact the undersigned at 732-321-3113 to discuss any matter regarding this application.

Respectfully submitted,

Siemens Corporation

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